RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-26 were filed and the claims amended herein. No new matter has been added. Reconsideration of the claims is respectfully requested.

B. Claim Objections

The claims are objected to for reciting incomplete deposit accession numbers. In response, Applicants note, as explained further below, that a deposit of seed of the claimed variety will be made with the ATCC and the corresponding deposit information will be inserted in the respective blanks in the claims and specification. The objections are therefore believed moot and removal thereof is thus respectfully requested.

C. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Action rejects the claims under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention.

(1) The Action rejects the claims for including blanks where seed deposit information is to be filled in. In response Applicants note, as explained further below, that a deposit of seed of the claimed variety will be made with the ATCC and the corresponding deposit information will be inserted in the respective blanks in the claims and specification. The rejection is therefore believed moot and removal thereof is thus respectfully requested.

(2) The Action asserts that claims 3 and 4 are indefinite for not further limiting the claims from which they depend. Applicants traverse as the claims are further

limiting. For example, claim 3 requires that the population of seed of claim 2 further be "an essentially homogeneous population of seed." Claim 4 further requires that the population of seed of claim 2 be "essentially free from hybrid seed." Nothing in claim 2 requires these elements. Rather the population merely needs to be "[a] population of the seed of claim." Nothing would require a population of seed according to claim 1 to be absolutely homogenous or completely free of some contaminating hybrid seed. For example, the relevant definition of "population" from the on-line version of the Merriam-Webster™ dictionary is "a body of persons or individuals having a quality or characteristic in common." In contrast, the definition for "homogeneous" from the same on-line dictionary is given as "of uniform structure or composition throughout." Therefore a collection of seed may at one time have a quality or characteristic in common, *e.g.*, be of a given variety, yet not be of uniform structure or composition throughout. A population can also contain contaminants. This is no different than claiming compositions comprising different specified purities of active ingredient. Claims 3 and 4 are therefore in proper dependent form and not indefinite. Withdrawal of the rejection is thus respectfully requested.

(3) The Action asserted that in claim 14 "capable of" is indefinite because it is unclear whether the plant does or does not express the physiological or morphological traits of the claimed variety. Applicants traverse as the term has a clear meaning in the art and claim breadth is not indefiniteness. One of skill in the art would understand whether a corn plant is capable of expressing all of the traits of the claimed corn plant because Appellants have provided the corn plant by way of a proffered biological deposit with the ATCC and have described the characteristics of this plant. One of skill in the art

would therefore readily ascertain whether a plant is capable of expressing all of the traits of the claimed variety based on direct comparisons under similar growing conditions. Because this standard is readily ascertainable, the use of the limitation in the claims is not indefinite.

Applicants also note that the same issue has been decided in applicants favor in a case presenting substantially identical issues. Specifically, on March 31, 2005 the Board of Patent Appeals decided six substantially similar appeals brought by the assignee: Appeal Nos: 2004-1503 (Ser No. 09/606,808), 2004-1506 (Ser. No. 09/788,334), 2004-1968 (Ser. No. 10/000,311), 2004-2317 (Ser. No. 09/771,938), 2004-2343 (Ser. No. 09/772,520); and 2005-0396 (Ser. No. 10/077,589) (collectively "the corn variety appeals"). The claims at issue in these cases were substantially identical in scope to those of the current case.

The same rejection was made and reversed, for example, in Appeal No. 2005-0396. In that case claim 20 read as follows "20. A corn plant regenerated from the tissue culture of claim 17, wherein the corn plant is capable of expressing all of the physiological and morphological characteristics of the corn variety designated I180580, wherein a sample of the seed of the corn variety I180580 was deposited under ATCC Accession No. PTA-3224." The Examiner rejected the claim on the same grounds as here, namely that because the claims use the term "capable" the claims do "not make clear if the plant actually expresses the traits, or when or under what conditions the traits are expressed." The Board reversed, explaining that

> To address the examiner's concerns, we find it sufficient to state that if a plant has the capacity to express the claimed characteristics it meets the requirement of the claim regarding 'capable of,' notwithstanding that due to a

> particular phase of the life cycle the plant is not currently expressing a particular characteristic. Alternatively, if a plant is incapable of expressing the claimed characteristics at any phase of the life cycle, because it lacks, for example, the 'transcription factor' required for expression - such a plant would not meet the requirement of the claim regarding "capable of."
>
> Here, we find the examiner's extremely technical criticism to be a departure from the legally correct standard of considering the claimed invention from the perspective of one possessing ordinary skill in the art. In our opinion, a person of ordinary skill in the art would understand what is claimed. *Amgen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). We find the same to be true for the phrase 'capable of' as set forth in claims 17 and 20.

Decision at p. 12.

In view of the foregoing, withdrawal of the rejection is respectfully requested.

(4) Claim 21 is rejected as unclear regarding "a corn genome." In response it is noted that the claim has been amended herein and that the rejection is believed moot. Removal of the rejection is thus respectfully requested.

D. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement

1. Rejection of claims 1-26

The Action rejects the claims under 35 U.S.C. §112, first paragraph, for lack of a seed deposit. In response, Applicant notes that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules. A declaration certifying that the deposit meets the criteria set forth in 37 C.F.R. §1.801-1.809 will be provided and the claims amended to recite the corresponding accession number. The specification will also be amended to include the accession number of the deposit and the date of deposit.

In view of the foregoing, removal of the rejection is respectfully requested.

2. Rejection of claims 20-24

The Action rejects claims 20-24 as not enabled. In particular it is asserted that enablement is lacking for methods involving backcrossing two or less generations. In response, Applicants note that claim 20, the limitations of which are included in claims 21-24, has been amended to recite "repeating steps (c) and (d) for at least three additional generations…." The rejection is therefore believed moot and removal thereof is thus respectfully requested.

E. Conclusion

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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